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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,961	07/30/2001	Hubert Schenkel	H 3475 PCT/U	2258

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EXAMINER
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SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 03/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/806,961

Applicant(s)

SCHENKEL, HUBERT

Examiner

Robert Sellers

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 15-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 15-43 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 15-19, 21, 22 and 34, drawn to a composition comprising copolymer (a), product (b) and epoxy resin (c).

Group II, claim 20, drawn to a composition comprising copolymer (a) reacted with a second epoxy resin, product (b) and epoxy resin (c).

Group III, claim 23, drawn to a composition comprising copolymer (a), product (b) reacted with excess polyepoxide and epoxy resin (c).

Group IV, claims 24-28 and 35, drawn to a composition, comprising copolymer (a), product (b), epoxy resin (c) and a latent hardener or accelerator.

Group V, claims 29 and 30, drawn to a process for bonding metallic and/or composite materials with the composition of Group IV.

Group VI, claims 31 and 36, drawn to product (c).

Group VII, claims 32 and 33, drawn to product (c) dissolved in (claim 32) or reacted with (claim 33) a polyepoxide.

Group VIII, claims 37 and 43, drawn to a process for preparing product (c).

Group IX, claim 38, drawn to the process of Group VIII further comprising combining product (c) with copolymer (a).

Group X, claim 39, drawn to the process of Group IX further comprising reacting product (c) with epoxy resin(s).

Group XI, claim 40, drawn to the process of Group X further comprising a second epoxy resin.

Group XII, claim 41, drawn to the process of Group XI further comprising hardener(s) and/or accelerator(s).

Group XIII, claim 42, drawn to the process of Group XII further comprising heating the composition to harden it.

The inventions listed as Groups I-XIII do not relate to a single general inventive concept under PCT Rule 13.1 since they lack the same or corresponding special technical features under PCT Rule 13.2. The special technical feature is embodied in claim 31 wherein product (c) is prepared by reacting excess (di)anhydride with a polyamine, and reacting the excess anhydride or carboxyl groups with excess polyphenol or aminophenol to yield a phenolic- or amino-terminated product.

Schmid et al. (col. 7, line 39 to col. 8, line 48 and col. 17, Example 1), European Patent No. 258,556 (page 4, lines 23-26 and 40-41; and page 6, Example I, Parts A and B) and European Patent No. 309,190 (pages 8-9, Example 1) show the reaction of an carboxyl-terminated dianhydride-polyamine adduct with an aminophenol to obtain a phenol-terminated polyimide. The special technical feature of claimed product (c) does not make a contribution over the prior art, thereby validating a holding of lack of unity.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

- 1) The epoxy-reactive groups-containing copolymers (a) wherein the type of copolymer (i.e. random or core-shell of claim 18) and species of monomers are identified.
- 2) The phenolic- or amino-terminated products (b) wherein the anhydride or dianhydride, diamine or polyamine and polyphenol or aminophenol are identified such as condensation product B) exhibited on page 15, lines 14-21 of the specification.
- 3) Contingent upon the election of Group IV, V, XII or XIII, the hardeners or accelerators such as one selected from claim 24.
- 4) Contingent upon the election of Group IV, an identification of a particular utility from the structural adhesive (claim 27), potting compound or a die-attach adhesive (claim 28).

Applicant is required, in reply to this action, to elect a single species from items 1) and 2), and 3) and 4) if appropriate to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added.

An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Claims 1-43 are generic.

The species listed hereinabove do not relate to a single general inventive concept under PCT Rule 13.1 since they lack the same or corresponding special technical features under PCT Rule 13.2. The special technical feature is embodied in claim 31 denoting phenolic- or amino-terminated product (c) which is shown in Schmid et al. and European Patent Nos. 258,556 and 309,190 as described hereinabove. The special technical feature of claimed product (c) does not make a contribution over the prior art, thereby validating a holding of lack of unity.

A written lack of unity is hereby proffered due to its complexity and in consideration of the foreign applicant. The reply to this requirement to be complete must include an election of the invention and species to be examined even though the requirement be traversed (37 CFR 1.143).

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Robert Sellers  
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